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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/696,161	10/29/2003	Peter C. Morris	200310633-1	7627

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EXAMINER

SHAH, MANISH S

ART UNIT	PAPER NUMBER
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2853

DATE MAILED: 09/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/696,161

Applicant(s)

MORRIS ET AL.

Examiner

Manish S. Shah

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8, 11-18, 21 and 22 is/are rejected.
- 7) ☒ Claim(s) 9, 10, 19 and 20 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 4/8/05; 10/29/03.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1-8, 11-18 & 21-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dickinson et al. (# GB 2316682 A) in view of Nelson et al. (# US 5395432).

Dickinson et al. discloses an inkjet recording method and an ink-jet printing system including a substrate; a visible inkjet ink composition configured to be ink jetted onto at least a portion of the substrate to form a first visible image on the substrate (black ink) (page: 8, line: 15-20); a first invisible composition configured to be ink jetted onto at least a portion of the substrate to form an invisible image on the substrate, the invisible image being associated with the first visible image (invisible color ink) (page: 8, line: 15-25); and a second invisible composition configured for over-striking at least a portion of the invisible image, wherein the first and second invisible composition are further configured to react and form a second visible image on the substrate (invisible color ink ) (page: 8, line: 15-25). They also disclose that the first and second invisible composition is an invisible ink (page: 8, line: 15-55). They also disclose that the second visible image is fluorescent (see Abstract; page: 9, line: 15-35). They also discloses a

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third invisible composition configured for over striking a portion of the second visible image (figure: 1, page: 8, line: 15-25). They also disclose that the first visible image is a character and second visible image is highlight or underline (page: 8, line: 3-15).

Dickinson et al. differs from the claim of the present invention in that (1) the first and second invisible composition are further configured to react and form a second visible image. (2) The first invisible composition includes the developer and the second invisible composition includes the invisible ink. (3) The first invisible composition includes the invisible ink and the second invisible composition includes the developer.

Nelson et al. teaches that to get the secure printing the first and second invisible (applicator) composition are further configured to react and form a second visible image (see Abstract). They also teaches that the first invisible composition includes the developer and the second invisible composition includes the invisible ink. or the first invisible composition includes the invisible ink and the second invisible composition includes the developer (column: 3, line: 10-25; column: 6, line: 30-35).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the inkjet printing system of Dickinson et al. by the aforementioned teaching of Nelson et al. in order to have a secure printing, which prevents from duplicating the printed image.

***Allowable Subject Matter***

2. Claims 9-10 & 19-20 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter:

(1) The invisible ink includes a developable colorant selected from the group consisting of phenolphthalein, thymolphthalein, p-nitrophenol.

(2) The developer includes an active ingredient selected from the group consisting of alkaline earth hydroxide, rare earth hydroxides, transition metal hydroxides, alkyl amines, alkanol amines and polyamines.


***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Manish S. Shah whose telephone number is (571) 272-2152. The examiner can normally be reached on 8:00am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen D. Meier can be reached on (571) 272-2149. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Manish S. Shah  
Primary Examiner  
Art Unit 2853

MSS

9/8/05